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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,644	12/02/2003	Gregory L. Todt	9820S-000002/DVB	4528

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EXAMINER	
ROSSI, JESSICA	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/725,644	TODT, GREGORY L.	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/20/06, RCE*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-20 and 34-42* is/are pending in the application.

4a) Of the above claim(s) *20 and 38-42* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-19,34-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

RCE

1. The request filed on 9/20/06 for a RCE under 37 CFR 1.114 based on parent Application No. 10/725,644 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. This action is in response to the amendment dated 9/20/06. Claims 14-20 and 34-42 are pending but claims 20 and 38-42 remain withdrawn **without traverse**, as set forth in paragraph 2 of the previous office action.

Priority

3. Application serial no. 09/664,896 does not have support for applying the adhesive to the nonwoven fabric in a predetermined pattern (only discloses applying adhesive pattern to the film). Also, Application '896 does not have support for the adhesive occurring along limited locations of the raised portions of the nonwoven fabric leaving a majority of the raised portions unbonded to the film.

While Application serial no. 10/079,642 does have support for applying the adhesive to the nonwoven fabric in a predetermined pattern, it does not have support for the adhesive occurring along limited locations of the raised portions of the nonwoven fabric leaving a majority of the raised portions unbonded to the film (see 112 1st paragraph new matter rejection set forth below).

Therefore, the **effective filing date** for the limitation pertaining to the adhesive being applied to the nonwoven fabric in a predetermined pattern is **2/20/02**. Provided Applicant can overcome the 112 1st paragraph new matter rejection set forth below, the **effective filing date** for

the limitation pertaining to the adhesive occurring along limited locations of the raised portions of the nonwoven fabric leaving a majority of the raised portions unbonded to the film is also **2/20/02**.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 14-19 and 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 14, the specification does not have support for a nonwoven fabric of *randomly oriented fibers*.

Also regarding claims 14 and 34, the specification does not have support for the adhesive occurring along *limited locations* of the raised portions of the nonwoven fabric *leaving a majority of the raised portions unbonded to the film*. The specification only discloses that the "adhesive should be maintained along the raised portions of the nonwoven as opposed to significantly entering the interstitial openings" and that the "nip pressure is set and constantly monitored to ensure that the adhesive remains along the raised portions of the nonwoven fabric to a very high degree" (p. 11, sections [0029-0030]).

While one can appreciate that the adhesive is intended to be located only along the raised portions of the nonwoven, there is nothing to suggest that the adhesive occurs along *limited locations* of the raised portions *leaving a majority of the raised portions unbonded to the film*. In fact, one reading the specification is inclined to think that adhesive is only applied to the raised portions of the nonwoven such that the adhesive-free areas of the predetermined pattern are those portions of the nonwoven that are not raised and extend between the raised portions.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14-19 and 34-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 14 and 34, it is unclear what Applicant means by the adhesive occurs along limited locations of the raised portions leaving a majority of the raised portions unbonded to the film. Does Applicant mean that adhesive is applied to so few of the raised portions such that a majority of the raised portions remain unbonded to the film? Or does Applicant mean that of the raised portions that have adhesive applied thereto, the adhesive does not cover the entire raised portion such that a majority of each of these raised portions remains unbonded to the film? Regardless of which interpretation was intended by Applicant, please note that neither has support in the present specification (see new matter rejection above).

Regarding claim 15, it is unclear what Applicant means by limited pressure? What pressure constitutes limited pressure? Applicant is asked to clarify.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 14-15 and 34-35 rejected under 35 U.S.C. 102(b) as being anticipated by Todt (WO 96/11804, of record).

*The following rejection is set forth without giving weight to the new matter limitation pertaining to the adhesive occurring along *limited locations* of the raised portions of the nonwoven fabric *leaving a majority of the raised portions unbonded to the film*.

With respect to claim 14, Todt teaches a method of manufacturing a material for protecting an object from surface damage (note this is intended use that does not further limit the scope of the claimed invention, MPEP 2111.02, II) comprising the steps of providing a shrinkable film 12 having a pre-determined shrink response when heat is applied thereto and a nonwoven fabric 14 of randomly oriented fibers having raised portions, applying an adhesive to the nonwoven fabric in a predetermined pattern defining first areas bearing the adhesive in the pattern (raised portions of nonwoven; p. 5, lines 2-6) and second areas (non-raised portions of nonwoven; p. 5, lines 2-6) substantially larger than the first areas extending between the pattern of the first areas bearing the adhesive, and adhering the nonwoven fabric and film together by said adhesive such that the adhesive occurs along the raised portions of the nonwoven fabric (Figure 1; abstract; p. 4, lines 17-23; p. 5, lines 2-18; p. 6, lines 12-25).

Regarding claim 15, Todt teaches the adhesive being a hot melt adhesive (p. 2, lines 16-18) and the nonwoven fabric being adhered to said film by pressing the film and nonwoven fabric together with limited pressure (p. 6, lines 17-20).

With respect to claim 34, all the limitations were addressed above with respect to claim 14 except applying the adhesive to the nonwoven. Todt teaches such (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 35, Todt teaches the adhesive being a pressure responsive adhesive and the nonwoven being adhered to the film by pressing the film and nonwoven together (p. 2, lines 16-18; p. 6, lines 12-20).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 16-19 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todt as applied to claims 14 and 34 above and further in view of the collective teachings of Ankuda (US 6638605, of record) and Woods et al. (US Re 36601, of record).

Regarding claims 16 and 36-37, Todt does not disclose any specifics with regards to the adhesive applicator and therefore it is unclear as to whether the adhesive applicator of Todt satisfies the claimed limitations.

Todt discloses that the adhesive is only applied to the raised portions of the nonwoven fabric thereby creating adhesive and non-adhesive areas on the nonwoven (p. 5, lines 2-6), which

clearly reads on Applicant's claimed 'predetermined pattern.' However, one reading Todt as a whole would have readily appreciated that the reference is not concerned with a particular adhesive applicator for forming the predetermined pattern.

Therefore, it would have been obvious to one of ordinary skill in the art to select an applicator, such as a gravure roll and doctor blade as set forth in the present claims, that deposits adhesive on only certain areas of a substrate such that a predetermined pattern comprising adhesive and non-adhesive areas is formed because such an applicator is well known and conventional in the art of applying a predetermined adhesive pattern to a nonwoven, as taught by the collective teachings of Ankuda (Figures 6-7; column 10, lines 54-60; column 11, lines 24-32 and 43-44) and Woods (Figures 6 and 12-13; column 5, lines 39-56; column 7, lines 28-33; column 8, lines 1-3), and this would ensure that only the raised portions of the nonwoven of Todt would have adhesive applied thereto.

One would appreciate that the pattern on the gravure roller would have to comprise a plurality of spaced-apart parallel grooves that extend completely around the circumference of the roller so that adhesive is only applied to the raised portions of the nonwoven of Todt; therefore, it is noted that Woods teaches such a gravure roller being known in the art (Woods teaches gravure roller 74 as shown in Figure 6 forms adhesive strips 134 separated by non-adhesive strips 136 on substrate 88 as shown in Figures 12-13).

Regarding claim 17, Todt teaches applying the adhesive to the nonwoven (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 18, Todt teaches the film and nowoven being intermittently bonded (p. 5, lines 1-18).

Regarding claim 19, Todt teaches the film being a shrinkable stretchable thermoplastic film (p. 4, lines 17-26).

12. Claims 14-15 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 2003/0087569) in view of Todt, or alternatively, Todt in view of Harris.

*The following rejection is set forth giving weight to the new matter limitation pertaining to the adhesive occurring along *limited locations* of the raised portions of the nonwoven fabric *leaving a majority of the raised portions unbonded to the film*.

With respect to claim 14, Harris teaches a method of manufacturing a material for protecting an object from surface damage (note this is intended use that does not further limit the scope of the claimed invention, MPEP 2111.01, II) comprising the steps of providing a shrinkable film having a pre-determined shrink response when heat is applied thereto (section [sections [0018, 0051]) and a nonwoven fabric of randomly oriented fibers having raised portions (section [0048]), applying an adhesive to the nonwoven fabric in a predetermined pattern defining first areas bearing the adhesive in the pattern and second areas substantially larger than the first areas extending between the pattern of the first areas bearing the adhesive, and adhering the nonwoven fabric and film together by the adhesive such that the adhesive occurs along limited locations of the nonwoven fabric (sections [0020, 0049]). It is unclear whether the reference teaches the adhesive occurring along limited locations of the raised portions of the nonwoven fabric leaving a majority of the raised portions unbonded to the film.

It is known to apply adhesive to only the raised portions of a nonwoven fabric that is bonded to a shrinkable film, in the manufacture of a material for protecting an object from surface damage, because this permits the nonwoven to aerate during the shrinking process thus

permitting the nonwoven to act as a cushion between the shrink film and object being protected, as taught by Todt (p. 5, lines 1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to apply the predetermined adhesive pattern of Harris to only raised portions of the nonwoven of Harris because applying adhesive to only raised portions of the nonwoven is known in the art, as taught by Todt, and this permits the nonwoven to aerate during the shrinking process thus permitting the nonwoven to act as a cushion between the shrink film and object being protected. One would readily appreciate that applying the predetermined adhesive pattern of Harris to only raised portions of the nonwoven would result in the adhesive occurring along limited locations of the raised portions leaving a majority of the raised portions unbonded to the film.

Alternatively, it would have been obvious to apply the adhesive of Todt in the predetermined pattern of Harris to only the raised portions of the nonwoven of Todt because applying adhesive in a predetermined pattern is known in the art, as taught by Harris, and this would further facilitate the aeration of the nonwoven desired by Todt during the shrinking process. One would readily appreciate that applying the adhesive of Todt in the predetermined pattern of Harris to only raised portions of the nonwoven of Todt would result in the adhesive occurring along limited locations of the raised portions leaving a majority of the raised portions unbonded to the film.

Regarding claim 15, Harris teaches the adhesive being a hot melt adhesive and the nonwoven fabric being adhered to said film by pressing the film and nonwoven fabric together with limited pressure (sections [0028, 0031, 0050]). Todt teaches the adhesive being a hot melt

adhesive (p. 2, lines 16-18) and the nonwoven fabric being adhered to said film by pressing the film and nonwoven fabric together with limited pressure (p. 6, lines 17-20).

With respect to claim 34, all the limitations were addressed above with respect to claim 14 except applying the adhesive to the nonwoven. Harris teaches such (section [0049]). Todt teaches such (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 35, one reading Harris would have appreciated that the reference is not particularly concerned with the type of adhesive (section [0028]). Therefore, it would have been obvious to use a pressure sensitive adhesive as an alternative to a hot melt because such is known in the art, as taught by Todt (p. 2, lines 16-18; p. 6, lines 12-20). Todt teaches the adhesive being a pressure responsive adhesive and the nonwoven being adhered to the film by pressing the film and nonwoven together (p. 2, lines 16-18; p. 6, lines 12-20).

Regarding claim 36, Harris teaches such (section [0020]).

13. Claims 16-19 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris and Todt, or alternatively, Todt and Harris as applied to claims 14 and 36 above, and further in view of the collective teachings of Ankuda et al. and Woods et al.

Regarding claims 16 and 37, Harris does not disclose any specifics with regards to the gravure roller arrangement and therefore it is unclear as to whether the arrangement satisfies the claimed limitations (section [0020]).

It would have been obvious to one of ordinary skill in the art to select a gravure roller arrangement, which comprises a gravure roller and doctor blade as set forth in the present claims, for applying the adhesive pattern of Harris in view of Todt, or alternatively Todt in view of Harris, because such an arrangement is well known and conventional in the art of applying a

predetermined adhesive pattern to a nonwoven, as taught by the collective teachings of Ankuda (Figures 6-7; column 10, lines 54-60; column 11, lines 24-32 and 43-44) and Woods (Figures 6 and 12-13; column 5, lines 39-56; column 7, lines 28-33; column 8, lines 1-3).

Regarding claim 17, Harris teaches applying the adhesive to the nonwoven (section [0049]). Todt teaches applying the adhesive to the nonwoven (p. 5, lines 1-4; p. 6, lines 12-15).

Regarding claim 18, Harris teaches the film and nowoven being intermittently bonded (sections [0020, 0049]). Todt teaches the film and nowoven being intermittently bonded (p. 5, lines 1-18).

Regarding claim 19, Harris teaches the film being a shrinkable stretchable thermoplastic film (section [0051]). Todt teaches the film being a shrinkable stretchable thermoplastic film (p. 4, lines 17-26).

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ormum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 14-19 and 34-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,074,288. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass the limitations set forth in the claims of the present invention.

Response to Arguments

16. Applicant's arguments filed 9/20/06 have been fully considered but they are not persuasive.

17. On p. 8 and 9, Applicant argues that Todt does not disclose applying the adhesive in a predetermined pattern, but merely discloses applying the adhesive to the raised portions. And since the raised portions are randomly oriented, Todt cannot be fairly interpreted as disclosing the application in a pattern to the raised portions.

The examiner is invited to reread the rejection set forth in paragraph 9 above where it is clearly established that Todt teaches applying the adhesive in a predetermined pattern when weight is not given to the new matter limitation. To reiterate, Todt intentionally applies the adhesive to only the raised portions of the nonwoven fabric thereby creating adhesive and non-adhesive areas on the nonwoven fabric (p. 5, lines 2-6), which clearly reads on Applicant's claimed 'predetermined pattern.' Stated differently, Todt intends for the nonwoven to have adhesive (raised portions) and non-adhesive areas (non-raised portions) before the adhesive is applied to the nonwoven; therefore, Todt applies the adhesive in a 'predetermined pattern.' Although Todt may not know exactly where the adhesive and non-adhesive areas will ultimately be located, due to the random orientation of the raised portions, this does not change the fact that

the adhesive is still applied in a predetermined pattern - albeit a random predetermined pattern - which the examiner points out is not excluded by the present claim language.

Regardless, the examiner invites Applicant to read the rejection set forth in paragraph 12 above where weight was given to the new matter limitation and Todt was modified in view of Harris to render Applicant's 'predetermined pattern' obvious.

18. On p. 9 of the remarks, Applicant argues that Ankuda and Woods are not properly combined with Todt because they are concerned with disposable surgical drapes and gowns that use non-heat shrinkable films and laminated pads.

The examiner would like to point out that these references were only used to show it being well known in the laminating art to apply adhesive in a predetermined pattern to a nonwoven fabric using a gravure roller arrangement that is identical to that being claimed by Applicant. Furthermore, the examiner would also like to point out that the newly applied reference to Harris applies a predetermined adhesive pattern to a nonwoven web that is adhered to a heat shrinkable film to make a material for protecting surfaces.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JESSICA ROSSI
PRIMARY EXAMINER